

Remarks/Arguments

A. Status of the Claims

Claim 19 is revised to incorporate the subject matter of claims 29 and 38, non-limiting support for which can be found in original claims 7 and 14. This claim is also revised to further define the lens as having concave and convex surfaces, non-limiting support for which can be found in the specification at page 5, lines 10-13, and 29. This claim is further revised to define the electrostatic film as a preformed film, non-limiting support for which can be found at page 8 of the specification (note the explanation that electrostatic films typically come in A4 sheets that can then be cut to a desired shape, as needed).

Claim 47 is also revised to incorporate the subject matter of claim 38, to further define the lens as having convex and concave surfaces, and to further define the electrostatic film as a preformed film. Non-limiting support for these amendments are identified in the above-paragraph.

Claims 29 and 38 are cancelled in view of the above amendments. Claim 45 is also cancelled, thereby rendering the indefiniteness rejection moot.

Therefore, claims 19-22, 25-28, 30-34, 36-37, 39-43, and 47 are pending, with claims 23-24 and 44 currently withdrawn from consideration.

B. Indefiniteness Rejection

Applicant respectfully requests withdrawal of the indefiniteness rejection in view of claim 45 being cancelled.

C. Obviousness Rejection Over Ohlin in view of Hage

Claims 19-21, 33, 34, and 36 are rejected under 35 U.S.C. § 103(a) for allegedly being obvious over Ohlin in view of Hage. Although Applicant respectfully disagrees with the Examiner, it is noted that current claim 19 incorporates the subject matter of non-rejected claims 29 and 38.

Therefore, Applicant submits that the current obviousness rejection is moot and respectfully requests that it be withdrawn. Applicant also submits that the rejection of dependent claim 37 is also moot and requests that it too be withdrawn.

D. Obviousness Rejection Over Conte in view of Lipman

Claims 19-22, 25-32, 38-43, 45, and 47 are rejected under 35 U.S.C. § 103(a) for allegedly being obvious over Conte in view of Lipman.

Applicant respectfully disagrees and notes that independent claims 19 and 47 both recite that the peelable film at least covers the central part of the **convex** surface of the lens. This feature is neither disclosed nor suggested in Conte and Lipman.

With respect to Conte, the Examiner concedes that this reference fails to disclose such an element.

As for Lipman, this reference plainly explains that its peelable film can be used to protect the concave and convex sides of the lens, but that when the film is applied to the convex side, it needs to have a portion removed to ensure that the mounting block is in contact with the lens and not the peelable film:

Obviously, the concave surface of the lens can also be protected using the same film material, except that the film for protecting the concave side need not be provided with an opening for the mounting block.

Lipman at col. 6, lines 56-59. This confirms that Lipman fails to disclose (and actually teaches away) using the peelable film to protect the central part of the convex surface of the lens. Indeed, the Lipman film is designed to do just the opposite. For instance, Figure 12 of this reference illustrates the opening created (dashed lines), which necessarily means that the central part of the convex side of the lens is not covered by the peelable film:

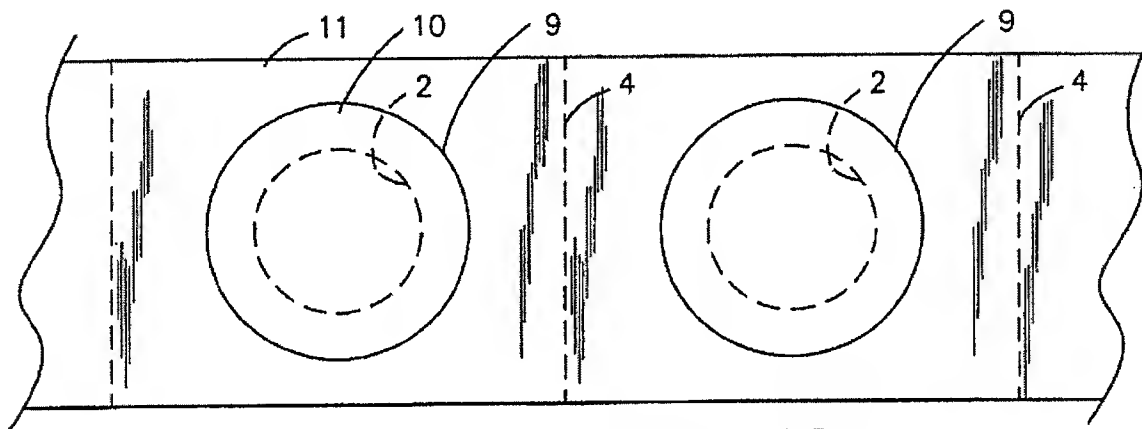


Fig. 12

Element 10 is the portion of the film that is designed to be adhered to the lens. Element 9 is a weakening line that is used to remove the excess material 11. Element 2 is an opening or aperture (col. 5, lines 53-57). This opening or aperture is there for a particular purpose, which is to ensure that the mounting block can make direct contact with the central part of the convex side of Lipman's lens:

The film is preferably provided in the form of a continuous film 3, with or without perforations 4 imprinted into the film for ease of separation of the film into individual sheets, and with a cut-away 2 provided in each sheet through which the mounting block can contact the lens. After the film has been applied to the lens, excess film protruding beyond the surface of the lens to be protected can simply be cut away.

See also Abstract and Figures 1-11. The element 2 opening or aperture is created **prior to the** film ever being applied to the lens. *Id.* That is, the central part of Lipman's film used for the convex side of the lens is always devoid of material when being applied to the convex side:

The film of the present invention can be applied by means of the widely available 3M Surface Saver Applicator (in which a continuous film without perforations could be used). **The film can be applied either before the LEAP pad and block are applied, since the film is provided with an opening which leaves exposed the area in which the mounting block is affixed to the lens, or the LEAP pad and block can be applied and then the protective film can be applied around the block.** The opening can be any size and any shape, but considering the objects of the invention, it will be apparent that the film should cover as much as possible of the lens surface area not covered by the block or LEAP pad.

Id. at col. 5, lines 30-42.

Further, Applicant submits that there is no apparent reason to redesign or modify Lipman's film to include material in its center portion when being applied to the convex side of the lens. Such a modification would add unnecessary steps of first adding the material with the idea that the material would have to be removed prior to edging, which would make Lipman's disclosed process less efficient. Further, such a modification would appear to prevent a user from applying the film to the convex side of the lens after the block has been affixed to said lens, which is an embodiment contemplated by Lipman ("...since the film is provided with an opening which leaves exposed the area in which the mounting block is affixed to the lens, or the LEAP pad and block can be applied and then the protective film can be applied around the block."). Therefore, this type of modification is contrary to Lipman's design parameters, which is evidence that such a modification is legally flawed. See MPEP § 2143.05(V) and (VI) ("If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification") ("If the proposed modification or combination of the prior art would change the principle of

operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”).

Applicant respectfully requests that the obviousness rejection in view of Conte and Lipman be withdrawn for at least these reasons.

E. Obviousness Rejection Over Conte in view of Spector

Claims 19-22, 25-34, 36-43, 45, and 47 are rejected under 35 U.S.C. § 103(a) for allegedly being obvious over Conte in view of Spector.

Applicant respectfully disagrees. A complete discussion of Conte can be found in Applicant’s previously filed response, which is incorporated by reference.

As for Spector, this reference describes the formation of a polymeric (peelable and removable” protective film (col. 8, line 14) at the surface of a lens wafer, starting from a liquid film forming composition. The film is generally made of PVC/vinyl polyacetate copolymer. It can be formed on every surface of the lens (col. 7, lines 62-63).

The Spector film, however, is not a film **electrostatically** adhering to the surface of the lens. Therefore, the combination of Conte and Spector fails to disclose or suggest at least Applicant’s claimed aspect of using an electrostatically adhering film.

Further, the Examiner appears to argue that the combination of Conte and Spector would be an effective combination. Applicant respectfully disagrees for at least the following reasons. There was no reasonable expectation of success that the combination of these references would be successful.

For instance, and in addition to the Spector film not being electrostatically adhered to the lens surface, said film is also not a preformed film as recited in claims 19 and 47. Rather, the film is formed by depositing and curing a liquid composition directly on the surface of the lens.

Adhesion of such a film to the lens surface is due to the fact that the film forming composition is cured in contact with the lens surface.

Also, the Spector film forming composition is not applied onto a temporary protective coating having a mechanically alterable outer layer that can be removed through friction and/or contact, as disclosed in Conte. If the Spector film forming composition were to be applied to a temporary coating such as that disclosed in Conte, the skilled person would expect that Conte's temporary coating would be peeled off by being stuck or altered upon removal of Spector's cured film forming composition.

Indeed, Conte's temporary coating weakly adheres to the underlying hydrophobic and/or oleophobic surface coating due to the surface properties of said surface coating. As well-known in the art, it is rather difficult to make a layer adhere to a hydrophobic and/or oleophobic surface coating. This explains why the temporary protective coating in Conte can be easily removed from such a hydrophobic/oleophobic surface.

What is surprising however, is Applicant's discovery that an electrostatic peelable film can be applied to the claimed temporary coating and can be removed therefrom without altering the effectiveness of the temporary coating. In this regard, Applicant's specification states:

Surprisingly, it has been found that such protective films can be removed from the lens surface without altering the temporary protective coating despite the high sensitivity thereof to alterations through friction and through contact....

Specification at page 8, lines 31-34.

Applicant's surprising technical achievement can be attributed to the use of a preformed film that is electrostatically adhered to the temporary protective layer.

Also, Applicant's specification explains that the degradation of the temporary protective coating is to be avoided when removing the preformed film. For if such degradation were to

occur, then the temporary coating would lose its ability to ensure sufficient contact between the lens surface and holding pad, which would result in an ineffective trimming of the lens.

By comparison, if Conte's temporary protective coating is removed when Spector's film is peeled away (which is to be expected given that the film is cured directly on the surface of the lens—see above), then Conte's temporary coating would lose its ability to provide the necessary adhesion between said coating and a holding pad during trimming. This results in an ineffective edging of Conte's lens. That is, if Conte and Spector were to be combined in a manner suggested by the Examiner, the end result would be destruction of Conte's temporary coating. Such a combination cannot be used to support the current obviousness rejection given that the intended purpose of Conte's coating would be rendered unsatisfactory. *See* MPEP § 2143.05(V).

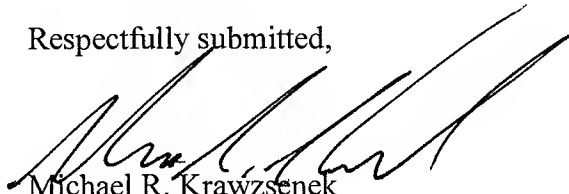
Therefore, Applicant's electrostatically adhering film and the Spector film cannot be said to be equivalents, as the end results would be quite different. Stated another way, it would not be reasonable to conclude that the use of Spector's film on Conte's coating would work to both protect Conte's coating and, once the Spector film is removed, allow Conte's coating to serve its purpose of ensuring sufficient adhesion between the lens and holding pad during trimming. Rather, it is likely that a person having ordinary skill in the ophthalmic field would be discouraged from following the path set out by the Examiner and would avoid using the Spector film with Conte's trimming process. In other words, there was no reasonable expectation of success that the combination of Conte and Spector would work, which is necessary to maintain the obviousness rejection. *See* MPEP § 2143.02 (I) ("The prior art can be modified or combined to reject claims as *prima facie* obvious **as long as there is a reasonable expectation of success.**") (emphasis added).

Applicant requests that the obviousness rejection based on the combination of Conte and Spector be withdrawn for at least these reasons.

F. Conclusion

Applicant believes that this case is in condition for allowance and such favorable action is requested. The Examiner is invited to contact the undersigned Attorney at 512.536.3020 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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